

DOCKET NO: HENN0012UPCT-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: FRANK PUTTKAMMER

APPLICATION NUMBER: 09/485,734

CONFIRMATION NO: 2153

FILED: February 14, 2000

EXAMINER: CAPUTO

GROUP: 2876

FOR: Constituting security elements with optical diffraction effect, and device for controlling
such elements

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 1.143 RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Sir:

In response to the non-final office action mailed November 27, 2006, please enter the
following response.

I. The Office Action

The cover page of the office action mailed November 27, 2006 indicates that claims 1-22 are subject to restriction. The body of the office action states that:

Restriction to one of the following intentions is required under 35 USC 121:

I. Claims 1-11, drawn to a structure for an optically effective diffraction security element, classified in class 235, subclass 491.

II. Claims 12-22, drawn to an apparatus for examining documents provided with optically effective diffraction elements which is characterized by a capacitively operating scanner the width of which is larger than the largest width of a document, classified in class 235, subclass 451.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the security element can be read by an apparatus other than the apparatus which is characterized by a capacitively operating scanner. The subcombination has separate utility such as being able to examine other security documents with different optically effective diffraction security elements. [Office action mailed November 27, 2006 page 2 lines 7-24.]

II. Response with Provisional Election and Traverse

In response, the applicant provisionally elects Group I, claims 1-11, **with traverse**. We traverse on the grounds that the restriction criteria applied by the examiner are

improper, that the examiner has admitted that application of the proper criteria does not result in restriction, and because the examiner has not shown that even under the applied criteria restriction would be proper.

III. Restriction Criteria are those applicable to PCT Applications

This is a PCT application in the national stage. It can only be subject to the criteria for unity of invention specified in the PCT. However, the office action applies US national application restriction criteria, which are improper. As a result, the current restriction requirement is legally improper. *I cannot legally be maintained.* Accordingly, the examiner should withdraw this restriction and examine the pending claims.

IV. The Examiner Admitted that the Claims Comply with the Unity of Invention Criteria

In the previous office action, the office action prior to the office action to which the paper responds, the examiner had applied the test for Unity of Invention and required the applicant to elect. The applicant traversed, and the examiner withdrew that requirement - - that requirement is not present in the outstanding office action. This means that the examiner withdrew that requirement, admitting that it was improper. Accordingly, there is no basis for restriction under the appropriate unity of invention criteria, and no other criteria is legally applicable. The examiner should therefore proceed to examine the pending claims.

V. The Outstanding Office Action Does Not Make Out a Case for Restriction, Even Under the Improper, But Applied, US Application Standards for Restriction

The US application criteria for restriction are improper since this is a PCT application. However, even under those standards, the examiner has not shown that restriction would be proper, as indicated in the following sections.

VI. The Examiner has not Met the Burden Required by MPEP 808, MPEP 816, and MPEP 806.05(c)(A)

MPEP Reasons for Insisting Upon Restriction 808, with emphasis supplied, states:

Every requirement to restrict has two aspects: (A) the reasons (**as distinguished from the mere statement of conclusion**) why the inventions as claimed are either independent or distinct; and (B) the reasons for insisting upon

restriction there between as set forth in the following sections.

MPEP 816 Give Reasons for Holding of Independence or Distinctness, with emphasis supplied, states:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. **A mere statement of conclusion is inadequate.** The reasons relied upon which the conclusion is based should be given.

For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

MPEP 806.05(c)(A) states in pertinent part:

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability.

The examiner has presented only conclusory reason why the inventions are distinct, thereby failing the requirements of MPEP 808, MPEP 818, or MPEP 806.05(c). The examiner has only presented the following conclusion:

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the security element can be read by an apparatus other than the apparatus which is characterized by a capacitively operating scanner. [Office action mailed November 27, 2006 page 2

lines 19-22.]

The examiner's assertion is conclusory because there is no evidence cited in support of the examiner's statement "the security element can be read by an apparatus other than the apparatus which is characterized by a capacitively operating scanner."

VIA. **The Examiner has not Met the Burden Required by MPEP 806.05(c)(B)**

MPEP 806.05(c)(B) states in pertinent part:

[T]he combination can be shown to have utility either by itself or in another materially different combination.

In reference to the MPEP 806.05(c)(B) requirement, the examiner presented the following conclusion:

The subcombination has separate utility such as being able to examine other security documents with different optically effective diffraction security elements. [Office action mailed November 27, 2006 page 2 lines 22-24.]

In response, the applicant points out that as with the discussion presented in Section III. above, the examiner has presented no evidence supporting the examiner's conclusion.

VII. **The Restriction Requirement Fails to Comply with MPEP 803**

MPEP 803 states the burden on the examiner for a search and examination of an entire application:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The applicant points out that the examiner has not shown that examining this application

imposes a serious examination burden, despite an allegedly separate classification. These are closely related sub classes. Moreover, the examiner has not explained why the two claim groups should be classified differently; mere conclusion is insufficient.

VIII. Closure

The requirement must withdrawn since it is based upon inapplicable criteria. Moreover, the examiner should now examine the pending claims.

Respectfully Submitted,

12/20/2006 /Richard Neifeld#35,299/

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March 13, 2006 (1:30pm)

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